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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,958	11/26/2001	Steven Barnes	11702/54246	6773

26869 7590 10/12/2004

DEVINE, MILLIMET & BRANCH, P.A.
111 AMHERST STREET
BOX 719
MANCHESTER, NH 03105

EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/992,958	Applicant(s) BARNES ET AL.	
	Examiner Jessica L. Rossi	Art Unit 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: 9-11.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/29/04 have been fully considered but they are not persuasive.
2. On page 4 of the arguments, Applicant argues that Culp and Nugent, together with the labeling apparatus of the Admitted Prior Art, fail to disclose a refrigerant storage tank as recited in claim 1. Applicant also argues that the examiner has failed to show how use of a heat-shrink sleeve on a refrigerant storage tank would have been obvious.

The examiner points out that Culp and Nugent were never combined with the labeling apparatus of the Admitted Prior Art and vice versa. Instead, the teachings of Culp and Nugent were used as motivation to apply a heat-shrinkable sleeve labeling apparatus to the refrigerant storage tank of the Admitted Prior Art as an alternative to the labeling apparatus of the Admitted Prior Art (paper label, tie-on tag, adhesive label) because such a labeling apparatus eliminates the need for separate fastening means (i.e., ties, adhesive) for attaching labels to the tank (Culp; column 3, lines 53-56), as set forth in paragraph 6 of the final office action dated 7/29/04.

As for use of a heat-shrink sleeve on a refrigerant storage tank being obvious, Applicant is invited to reread the previous paragraph.

3. On page 4 of the arguments, Applicant argues that neither Culp nor Nugent disclose a refrigerant storage tank.

The examiner appreciates that neither Culp nor Nugent disclose a refrigerant storage tank and it is exactly for this reason that Culp and Nugent were only used as secondary references to modify the teachings of the Admitted Prior Art, which is directed to a refrigerant storage tank

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and its labeling apparatus. Specifically, Culp was only used to show it being known in the storage tank labeling art to apply a label in the form of a heat-shrinkable sleeve to a storage tank thereby eliminating the need for adhesive labels whereas Nugent was only used to show it being known in the labeling art to treat the surface of a heat-shrinkable PVC sleeve label to allow for writing thereon.

4. On page 4 of the arguments, Applicant argues that since the examiner has not shown that Culp and Nugent, when combined with the labeling apparatus of the Admitted Prior Art, teach or suggest all the limitations of claim 1, the examiner has failed to establish a prima facie case of obviousness.

The examiner points out that Culp and Nugent were never combined with the labeling apparatus of the Admitted Prior Art and vice versa. Instead, the teachings of Culp and Nugent were used as motivation to apply a heat-shrinkable sleeve labeling apparatus to the refrigerant storage tank of the Admitted Prior Art as an alternative to the labeling apparatus of the Admitted Prior Art (paper label, tie-on tag, adhesive label). See paragraph 9 below for establishing prima facie case of obviousness.

5. On pages 4-5 of the Arguments, Applicant argues that because Culp does not teach applying the heat-shrinkable labeling sleeve to a refrigerant storage tank the reference provides no motivation for using the heat-shrinkable sleeve for labeling a refrigerant storage tank.

First, the examiner appreciates that Culp teaches applying the heat-shrinkable labeling sleeve to a propane storage tank and not a refrigerant storage tank. However, the examiner relied on Culp solely for its general/broader teaching of using a heat-shrinkable sleeve to label a storage tank. Second, Culp teaches such a heat-shrinkable labeling sleeve eliminating the need

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for adhesive labels (Culp; column 3, lines 53-56), which is clearly motivation to use such a heat-shrinkable sleeve as an alternative to the labeling apparatus (paper label, tie-on tag, adhesive label) for the storage tanks of the Admitted Prior Art, as set forth in paragraph 6 (page 4) and paragraph 8 (page 6) of the final office action dated 7/29/04.

6. On page 5 of the arguments, Applicant argues that there is no motivation to combine Culp and the labeling apparatus of the Admitted Prior Art because Culp is directed to a propane storage tank and not a refrigerant storage tank. Applicant argues that propane tanks are always the same shape and are always filled with propane so there is no need for a removable label to be removed each time the tank is filled and replaced with a new label to indicate the new contents.

First, the examiner once again points out that Culp was never combined with the labeling apparatus of the Admitted Prior Art. Second, the examiner appreciates that Culp is directed to a propane storage tank and not a refrigerant storage tank. However, as stated above, the examiner relied on the Culp reference for its broader teaching of using a heat-shrinkable sleeve for labeling a storage tank in order to eliminate the need for adhesive labels (column 3, lines 53-56).

Furthermore, the present claims are directed to a system wherein the labeling apparatus, or sleeve, need only be capable of being removed (MPEP 2115, 2100-60) wherein the skilled artisan would have appreciated that the sleeve of Culp is capable of being removed as set forth in paragraph 6 (page 4) of the final office action.

7. On page 5 of the arguments, Applicant argues that even upon combining the paper labels, tie-on tags, and adhesive labels of the Admitted Prior Art with the propane tank and heat-shrinkable sleeve of Culp, the result would not be the present invention because there is no refrigerant storage tank.

Once again the examiner points out that the labeling apparatus (paper labels, tie-on tags, adhesive labels) of the Admitted Prior Art was never combined with the propane tank and heat-shrinkable sleeve of Culp. Instead, the refrigerant storage tank labeling system of the Admitted Prior Art was modified in light of the teachings of Culp such that the labeling apparatus of the Admitted Prior Art (paper labels, tie-on tags, adhesive labels) was replaced by the heat-shrinkable labeling sleeve of Culp because a heat-shrinkable sleeve eliminates the need for separate fastening means (i.e. ties, adhesive) for attaching a label to the storage tank, as set forth in paragraph 6 of the final office action.

8. On pages 5-6 of the arguments, Applicant disagrees with the examiner's position that Culp was relied upon for its broader teaching of using a heat-shrinkable sleeve for labeling a storage tank in order to eliminate the need for adhesive labels. Applicant argues that Culp is clearly directed to a propane storage tank and there is absolutely no mention or suggestion in Culp of any other type of tank except a propane storage tank.

It is the examiner's position that one skilled in the storage tank labeling art would have been motivated at the time of the invention to look to a teaching directed to labeling a storage tank regardless of any differences between the contents within the tank of the invention and the tank of the teaching, especially when that teaching provides motivation to use its particular labeling apparatus to replace another less desirable labeling apparatus (Culp teaches using heat-shrinkable sleeve to replace less desirable adhesive labels when labeling storage tank).

The examiner would like to point out that Applicant is basically arguing that Culp cannot be combined with the refrigerant storage tank of the Admitted Prior Art because Culp fails to teach all the limitations of claim 1, specifically the storage tank being a refrigerant storage tank.

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The examiner points out that if a secondary reference could only be used in a 103 rejection if it taught all the limitations set forth in the claimed invention there would be no need for a 103 rejection since the secondary reference could be used to make a 102 rejection.

9. On page 6 of the arguments, Applicant argues there is no motivation to combine the Admitted Prior Art with Culp and even when combined, the result does not include each and every limitation of claim 1, and therefore the examiner has failed to establish a prima facie case of obviousness.

Three criteria must be met to establish a prima facie case of obviousness: motivation, reasonable expectation of success, and all the claimed limitations must be taught or suggested.

Regarding the first criteria, one skilled in the art would have been motivated by the teaching of Culp to apply a labeling apparatus in the form of a heat-shrinkable sleeve to the refrigerant storage tank of the Admitted Prior Art as an alternative to the labeling apparatus (paper labels, tie-on tags, adhesive labels) of the Admitted Prior Art because such a labeling apparatus is known in the storage tank art, as taught by Culp, wherein such an apparatus eliminates the need for separate fastening means (i.e. ties, adhesive) for attaching a label to the storage tank (Culp; column 3, lines 53-56), as set forth in paragraph 6 of the final office action. One skilled in the art would also have been motivated to treat the sleeve of the Admitted Prior Art in view of Culp so as to make the surface appropriate for the handler to write content information thereon in addition to the general labeling information because a heat-shrinkable, PVC sleeve having a treated surface to allow for both general labeling and writeable portions for providing content information thereon is known, as taught by Nugent (column 2, line 39; column

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3, lines 5-15 and 56), wherein the writeable portion allows for user-specific information to be recorded on the sleeve during handling, as set forth in paragraph 6 of the final office action.

Regarding the second criteria, the skilled artisan would have appreciated applying heat shrinkable sleeves to a variety of objects is common practice in a variety of arts, including the storage tank art as evidenced by Culp, and therefore the skilled artisan would predict a reasonable expectation of success.

Regarding the third criteria, and as set forth above and in paragraph 6 of the final office action, the Admitted Prior Art taken with the teachings of Culp and Nugent does teach or suggest all the claimed limitations – specifically those set forth in present claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica L. Rossi
Patent Examiner
Art Unit 1733